

REMARKS/ARGUMENTS

Claims 1-80 are pending in the instant application. In the referenced Office Action, the Examiner has rejected all claims under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication 2002/0038363 A1 to MacLean (hereinafter, MacLean 2002/0038363). The earliest priority date for MacLean appears to be September 28, 2000; the filing date of a provisional patent application no. 60/235,973 to which it claims priority (hereinafter, MacLean provisional application).

Applicant herein contends that the inventors of the present patent application conceived of their invention prior to the MacLean 2002/0038363 priority date, and diligently reduced it to practice until filing of the present application. Additionally, Applicant contends that MacLean provisional application, from which MacLean 2002/0038363 claims priority, is not enabling for the teachings asserted by the Examiner in rejecting claims 1-80 of the present application. Entry of this amendment is respectfully requested under M.P.E.P. § 714.13, since no claims are amended by this paper and it's entry is anticipated to place the case in condition for allowance.

1. Prior Conception and Diligence:

A 35 U.S.C. 102(e) reference may be overcome by antedating the filing date of the reference by submitting an affidavit or declaration under 37 C.F.R. 1.131. M.P.E.P. §§ 715 and 2136.05. One way to antedate a reference is to provide sufficient facts to show conception of the invention prior to the effective date of the reference coupled with diligence from a date prior to that reference date to the filing date of then application. M.P.E.P. § 715.07.

The "invention" refers to the subject matter of the claims. The purpose of the Rule 131 showing is to broadly establish possession of the invention. A Rule 131 declarant need not necessarily show possession of the entire invention as later claimed; it is sufficient that he shows possession of enough to make the entire invention obvious to one of ordinary skill in the art. See In re Spiller, 500 F.2d 1170, 1176, 182 USPQ 614, 618-19 (CCPA 1974).

The attached Declaration is signed by each of the named inventors in accordance with M.P.E.P. § 715.04. That Declaration asserts, at numbered paragraph 2 of that Declaration, that the inventors of the present application conceived of their invention at least as early as August 29, 2000. This date predates the earliest priority date of MacLean 2002/0038363. Exhibit A is evidence of that conception in six, single sided and numbered pages. While conception by the present inventors may have been earlier than August 2000, that is the earliest evidence the Applicants submit at this time.

For all Exhibits, redacted portions obliterate only personal information (employer personnel numbers, email addresses, phone numbers, etc.) that are not relevant to conception and/or diligence. Additionally, for Exhibit A only, certain redacted portions obliterate privileged business information that is not relevant to conception and/or diligence.

Specifically, conception of the invention recited in pending claim 1 may be broadly found at numbered paragraphs 2 and 3 (e-commerce filter in a network) combined with #1 under the sub-heading "A possible start for claims:" (where the 'parties' relate to the claimed network components) at pages 2 and 3 respectively, of Exhibit A. Conception of the claim 1 clause "independent of a particular electronic commerce program" is shown at page 2 of Exhibit A under the subheading "The solution:", where the present 'generic solution' is distinguished over the 'classic integrated approach' and is stipulated in several bulleted points as a 'Uniform policy over different e-Commerce systems'; as adaptable 'without re-deploying the e-Commerce systems'; and as insertable 'without the knowledge or participation of the e-Commerce system vendor'. These and other specific disclosures within Exhibit A further show conception for each of the remaining independent claims 26, 27, 29, 31, 32, 62 and 70.

Applicant submits that Exhibit A evidences conception of the claimed invention in such detail as to clearly exceed the minimum requirements recited above from In re Spiller.

Diligence is shown in the Declaration at numbered paragraphs 3-6 and Exhibits B through D. Specifically, Exhibit B is a copy of an email evidencing a meeting concerning the invention on September 7, 2000 (the date prior to the email of Exhibit B). Exhibit C is a

copy of a Supplementary Invention Report in fourteen numbered pages (two-sided) generated in response to the meeting noted in Exhibit B. Exhibit C evidences further reduction to practice between September 8, 2000 and October 9, 2000. Exhibit C bears a stamped date of October 11, 2000, but was earlier attached to the email of Exhibit D which itself is dated October 9, 2000.

Exhibits E through H relate to preparation of the patent application. Exhibit E is a copy of the first page of a letter dated October 31, 2000 whereby the invention was first submitted to outside counsel for the purpose of preparing a U.S. patent application (received on November 1, 2000); Exhibit F is a copy of an email of which the lower portion recites a first draft patent application was sent to the lead inventor, Mr. John F. Morar, on January 20, 2001; Exhibit G is a copy of a letter evidencing a second draft patent application was sent to that same lead inventor on January 31, 2001; and Exhibit H is a copy of a letter evidencing that a final draft of the patent application, with formal papers, was sent to that same lead inventor on February 5, 2001. The filed patent application is an exact copy of that final draft, so it necessarily represents reduction to practice. The Applicant's showing is summarized in the following table:

<u>Reference</u>	<u>Dates</u>	<u>Activity</u>	<u>Asserted showing</u>
Exhibit A	Aug. 29, 2000	Invention Report	Conception
Exhibit B	Sept. 7-8, 2000	Meeting and Email	Diligence
Exhibit C	Oct. 9-11, 2000	Supplementary Invention Report	Diligence
Exhibit D	Oct. 9, 2000	Email with Exhibit C attached	Diligence
Exhibit E	Oct. 31 to Nov. 1, 2000	Invention sent to outside counsel for drafting of patent application.	Diligence
Exhibit F	Jan. 20, 2001	First draft sent to inventors	Diligence
Exhibit G	Jan. 31, 2001	Second draft sent to inventors	Diligence
Exhibit H	Feb. 5, 2001	Final draft sent to inventors	Reduction to Practice
Application	Feb. 15, 2001	Application filed with US PTO	Reduction to Practice

Applicant notes that the above reveals only two time periods wherein a month or more elapses without separate documentation as to diligence. As to the period Sept. 8 to Oct. 9,

2000, the period ends with the email of Exhibit D to which was attached the Supplementary Invention Report of Exhibit C. Exhibit C itself evidences a compilation of work performed over a period of time commensurate with the content of Exhibit C, and therefore proves diligence for more than merely the one day it was electronically sent. This is similar to Exhibits F and G; the second draft evidences an inventor review and attorney edit of the first draft, events that occurred between the dates of the first and second drafts.

The remaining period is between Nov. 1, 2000 and Jan. 20, 2001. This period ends with the preparation of a first patent application draft, another compilation of work performed over a period of time preceding the documented email date. Furthermore, caselaw holds that once an invention is submitted to an attorney for drafting of a patent application, diligence is satisfied when the attorney takes up work in a reasonable order. “[D]ecisions (as to the order in which a patent attorney prepares cases) recognize that the pressure of other business on a patent attorney may be a sufficient excuse for delay in filing provided the attorney takes up work in a reasonable order...” *Chisum on Patents*, vol 3, ch. 10.07[4][e] (Matthew Bender & Co., Inc., Rel. 82-3/02). Gould v. Schawlow, 150 USPQ 634 (CCPA 1966); Rines v. Morgan, 116 USPQ 145, 148 (CCPA 1957) (“it is not necessary that an inventor or his attorney should drop all other work and concentrate on the particular invention involved; and if the attorney has a reasonable backlog of work which he takes up in chronological order and carries out expeditiously, that is sufficient.”). The undersigned asserts that based on a personal interview, the attorney preparing the case had a reasonable backlog of patent cases that he took up in a reasonable order during the entire period from November 1st, 2000 to January 20th, 2001.

The Applicant hereby asserts that the showing provided herein evidences conception of the invention prior to the effective date of MacLean 2002/0038363, coupled with diligence from prior to the reference date to constructive reduction to practice, the filing of the patent application on February 15, 2001.

2. The MacLean Provisional Application Fails to Anticipate the Pending Claims:

In the alternative, should the Examiner rule insufficient the above showing of prior conception and diligent reduction to practice, Applicant asserts that relevant and substantive

portions of MacLean 2002/0038363 are not enabled by the MacLean provisional application for the teachings asserted as anticipatory in the outstanding rejection. M.P.E.P. § 2136.02 requires that "subject matter not included in the patent or application publication itself can only be used when the subject matter becomes public." While 35 U.S.C. 102(e) provides that the 'public' date of a reference may be considered its filing date, in the present instance, only the subject matter of the cited MacLean 2002/0038363 that finds enabling support in the MacLean provisional application is entitled to the earlier filing date of the provisional (September 28, 2000). This mirrors the requirement of M.P.E.P. § 2136.03, part IV, wherein the filing date of a parent application may only be used as the priority date under 102(e) only if that parent application supports the claims of the issued child application; matter that is new in a subsequent application does not carry the priority date of a previous application from which benefit is claimed.

Exhibit I is a copy of the MacLean provisional application from which MacLean 2002/0038363 claims priority, as provided by the US PTO. At page 3 of the outstanding Office Action, the Examiner recites that MacLean 2002/0038363 discloses: inputting the electronic commerce transaction to an electronic transaction filter ... for enabling the filter to interpret at least one characteristic of the transaction in a manner that is independent of a particular electronic commerce program that originated the messages and message data. Assuming *arguendo* that MacLean 2002/0038363 does disclose and teach the above, those teachings are not enabled by or even present in the MacLean provisional application.

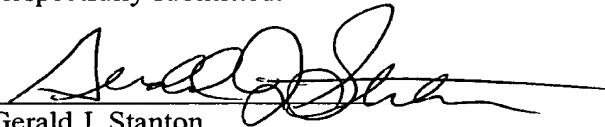
First, the MacLean provisional application fails to include any drawings where necessary to understand the subject matter, as required under 35 U.S.C. § 113 and M.P.E.P. § 608.02. ("The examiner should require drawings in almost all such instances."). This represents a lack of enablement. Second, the MacLean provisional application is not seen to include disclosure concerning an electronic commerce filter or its specific claimed characteristics. This represents a lack of disclosure. It appears that all references to filters in MacLean 2002/0038363 constitute new matter to the MacLean provisional application. Thus, any disclosure and/or teaching in MacLean 2002/0038363 that relates to electronic commerce filters carries a priority date of February 13, 2001, and not September 28, 2000.

Appl. No. 09/783,897
Amdt. Dated April 6, 2004
Reply to Office Action of January 30, 2004

For the present application, the above showing and Exhibit H evidence that the final draft of the present application was prepared no later than February 5, 2001; and that final draft was later filed unchanged. If the filed application represents constructive reduction to practice, then the *identical* final draft of February 5, 2001 does also. The ten-day period from February 5 to filing of the application on February 15 was occupied by review of the final draft by each of the six named inventors, procuring each of their signatures on the Oath and Assignment, and submitting the executed formal papers to the drafting attorney for filing. Whether or not the Examiner agrees that conception and diligence is sufficiently demonstrated by the evidence submitted herein to predate the earliest MacLean filing date, that same evidence proves constructive reduction to practice by February 5, 2001, eight days prior to the earliest MacLean disclosure that the Examiner cites as anticipatory.

In light of the above arguments, Applicant respectfully requests that the Examiner withdraw all outstanding rejections and pass claims 1-80 to issuance without further delay. Applicant invites the Examiner to discuss any remaining concerns, if there be any, with the undersigned representative via telephone at his discretion.

Respectfully submitted:


Gerald J. Stanton
Reg. No.: 46,008

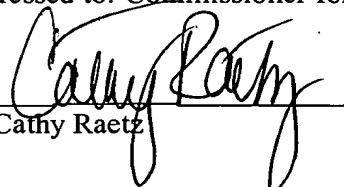
April 6, 2004
Date

Customer No.: 29683
HARRINGTON & SMITH, LLP
4 Research Drive
Shelton, CT 06484-6212
Phone: (203) 925-9400
Facsimile: (203) 944-0245
Email: gstanton@hspatent.com

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

April 6, 2004
Date


Cathy Raetz